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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/702,298

10/31/2000

Steven A. Bogen

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EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

03/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/702,298	Applicant(s) BOGEN ET AL.	
	Examiner Lyle A. Alexander	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al. (USP 5,273,905).

Muller et al. teach a method and apparatus for the sequential multi-stop processing of slides for staining comprising a liquid dispensing means, heating means and aspiration means. Column 4 lines 4+ teach microprocessor control of both the heating and movement of the sample to chambers of different volumes based upon desired analysis. This has been read on the claimed "... dispenser orifice and slide housing being capable of relative movement to each other under microprocessor control ..." (e.g. the dispensing orifice is move to a different chamber based upon the analysis and volume required). Column 4 lines 27+ teach multiple processing stations that are

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modular in design having "quick connect/disconnect" means to fluidic and electrical supplies which has been read on the claimed "... hose transport mechanism...".

Column 15 lines 8+ teach block member(37) with good heat transfer characteristics is adjacent to the glass slide which has been read on the claimed "heater"/"heating element is adjacent to the slide". Column 66 lines 54+ teach the fluid is remove "either by suction or by flowing a washing fluid or the like through the chamber..." and has been read on the claimed "liquid aspirator".

With respect to the 3/17/08 amendments, the new limitations "... liquid is dispensed from above ..." has been read on figure 18 where conduits(132,133) are "above" chamber(116) and supply the sample to the chamber(116). The new limitations "... each cavity being mounted on separate structures that provide relative movement of the supply input between the orifice and each cavity ..." has been read on the taught valve(129) that provides relative movement of each of the supply lines of reservoirs (R1-R11).

Muller et al. teach manually placing a single slide into a slide cavity and is silent to the claimed "... mounted on separate structures ..." which requires a plurality of slide cavities.

The court decided In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) that if the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. The facts of this case are similar. Muller et al. fails to teach plural slide mounting structures. It would have been advantageous to provide multiple slide

mounting structures to achieve the expected result of process more than one slide simultaneously. In the absence of a showing of new and unexpected results, it would have been within the skill of the art to modify Muller et al. and provide a plurality of slide mounting structures that would be in fluid communication with the reservoirs (R1 -R11) through valve(129) to gain the expected results of process more slides simultaneously.

Response to Arguments

Applicant's arguments filed 11/14/08 have been fully considered but they are not persuasive.

Applicant summarizes the instant invention as having a slide rotor(504), a reagent rotor(506) and arcuate cartridge frame(534), etc. The Office notes none of these limitations are presently claimed and these remarks are not commensurate in scope with the pending claims.

Applicant states Muller fails to teach the claimed limitations "...a liquid dispenser including an orifice decoupled from each cavity from which liquid is dispensed from above ...". Muller teaches in figure 18 conduits(132,133) that are "above" chamber(116). The Office maintains this language is sufficiently broad to have been properly read on Muller.

Applicant states Muller fails to teach the claimed "... each cavity being mounted on separate structures that provide relative movement between the orifice and each cavity ...". The Office does not agree and maintains input reservoir(116) is placed over each slide and forms a *cavity* into which the appropriate fluids/reagents are dispensed

to the slides. The *cavity* created by reservoir(116) supplied the fluids/reagents from above and meets the instant claims.

Applicant states Muller fails to teach orifices and cavities mounted on separate structure that provide relative movement. The Office maintains Muller et al. teach the reservoir(116) is sequentially(e.g. relatively) moved onto each slide and creates a separate *cavity* on the slide. Muller has been properly read on the pending claims.

Applicant states Muller fails to teach liquid aspirator decoupled from each slide cavity as required by claim 3. The Office maintains the reservoir(116) is attached and detached to each slide and has been properly read on the claimed *decoupling*.

Applicant traverses the rejections of claims 10,17 and 18 because Muller does not teach “bringing the end of the vacuum hose transport mechanism to the selected cavity.” Muller teach positioning cavity(116) on each slide which include a vacuum hose and has been properly read on these claims.

With respect to the 11/14/08 IDS, the only cited reference that teaches a vacuum and aspiration means is USP 7,217,392 which has a different inventive entity and an effective filing date 2/27/98. The Office has considered the pending application as having an effective filing date for the subject matter that includes a vacuum and aspirating means as going back to at least 7/02/97 from the CIP of USP 5,947,167. Therefore USP 7,217,392 does not qualify as prior art based upon its later effective filing date.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
Art Unit 1797

/Lyle A Alexander/
Primary Examiner, Art Unit 1797